

REMARKS

By this Response, Applicant has canceled claims 37 and 38 without prejudice or disclaimer, and has amended claims 1, 41, and 44. No new matter has been added. Claims 1-36 and 39-45 are present in the application. Of those claims, claims 13-16, 18, 19, 21-36, 39, 40, 42, and 43 have been withdrawn from further consideration in this application as being directed to non-elected subject matter. Thus, claims 1-12, 17, 20, 41, 44, and 45 are pending on the merits. For at least the reasons outlined herein, Applicant respectfully submits that claims 1-12, 17, 20, 41, 44, and 45 are allowable and respectfully requests allowance of this application.

I. Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1 and 44 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Office Action at 2. In particular, the rejection statement asserts that the originally-filed application fails to support the subject matter included in the amendments to claims 1 and 44 included in the Response to Office Action filed September 15, 2009. Id. Although Applicant respectfully submits that this claim rejection is improper, Applicant has amended claims 1 and 44 in order to expedite issuance of a Notice of Allowance for this application. In particular, Applicant has amended claims 1 and 44, respectively, to recite, in pertinent part, “wherein the calcined kaolin has a median particle size ranging from at least about 1 μm to about 3 μm ,” and “wherein the composition has a median particle size of at least about 1 μm ” Therefore, Applicant respectfully requests

reconsideration and withdrawal of the claim rejection under 35 U.S.C. § 112, first paragraph.

II. Claim Rejection under 35 U.S.C. § 102(b) based on Slepetys

Claims 44 and 45 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,393,340 to Slepetys et al. ("Slepetys"). Final Office Action at 3. Claim 44 is independent, and claim 45 depends from independent claim 44. Applicant respectfully submits that independent claim 44 is patentably distinguishable from Slepetys because Slepetys fails to disclose or render obvious all of the subject matter recited in claim 44.

Independent claim 44 is directed to a composition comprising calcined kaolin, wherein "the composition has an oil absorption of at least about 100%." For at least the reasons outlined below, Slepetys fails to disclose or render obvious at least this subject matter recited in independent claim 44.

The rejection statement concedes that Slepetys does not expressly disclose the above-noted subject matter, but asserts that U.S. Patent No. 6,136,086 to Hen et al. ("Hen") "is cited as factual evidence that at least the Ansilex™ 93 example of Table VI [(of Slepetys)] has a[n] oil absorption within the scope of the instant claims (105-120%)." Final Office Action at 3. The rejection statement also asserts that "[t]he similar disclosed uses as hiding pigments also suggest[s] that the materials of the patent and those of the instant claims share characteristics." Id. Thus, the rejection statement, conceding that Slepetys does not expressly disclose the oil absorption of its disclosed compositions, asserts that because ANSILEX 93®, a product mentioned in Slepetys for comparison purposes, has the recited oil absorption, the compositions taught by

Slepetys inherently have the oil absorption characteristic recited in independent claim 44.

Applicant respectfully disagrees with the assertions and traverses the rejection of independent claim 44 based on Slepetys because Slepetys distinguishes its disclosed compositions from ANSILEX 93[®], and thus, Slepetys's disclosed compositions do not necessarily possess the characteristics of ANSILEX 93[®]. In other words, Slepetys does not expressly disclose a calcined kaolin composition having an oil absorption of at least about 100%. Thus, the rejection statement must be relying on a theory that Slepetys inherently discloses the recited oil absorption. However, as explained below, Slepetys does not inherently disclose the recited oil absorption characteristic.

The M.P.E.P. cautions that "[i]nherency . . . may not be established by probabilities or possibilities." § 2112 (citation omitted). In particular, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." Id. (citation omitted). Thus, to "rely[] upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Id. (citation omitted).

Applicant respectfully submits that the metakaolin pigments disclosed in Slepetys do not necessarily have an oil absorption at least about 100%. The rejection statement relies on the oil absorption characteristic of ANSILEX 93[®] in order to show that the Slepetys metakaolin compositions have an oil absorption of at least about 100%. Final Office Action at 3. However, Slepetys distinguishes its metakaolin compositions from

ANSILEX 93[®] by disclosing that those compositions have different characteristics than ANSILEX 93[®]. See Slepetys, col. 1, line 41, through col. 2, line 29. Thus, it is not necessarily true that the Slepetys metakaolin compositions have the same oil absorption characteristics as ANSILEX 93[®]. Because it is not necessarily true that the Slepetys metakaolin compositions have an oil absorption of at least about 100%, Slepetys does not inherently disclose this characteristic.

For at least the above-outlined reasons, Slepetys fails to disclose, either expressly or inherently, all of the subject matter recited in independent claims 44. Therefore, Slepetys does not anticipate independent claim 44, and the § 102(b) rejection of claim 44 based on Slepetys should be withdrawn. Further, claim 45 depends from independent claim 44, and thus, it is distinguishable from Slepetys for at least the same reasons as independent claim 44. Therefore, Applicant respectfully requests reconsideration of the rejection of claims 44 and 45 under § 102(b) based on Slepetys.

III. Claim Rejection under 35 U.S.C. § 103(a) based on Slepetys and Bilimoria

Claims 1-12, 17, 20, 37, 38, and 41 were rejected under 35 U.S.C. § 103(a) based on Slepetys in view of U.S. Patent No. 6,312,511 B1 to Bilimoria et al. ("Bilimoria"). Final Office Action at 4. By this Response, Applicant has canceled claims 37 and 38 without prejudice or disclaimer. Of the remaining rejected claims 1-12, 17, 20, and 41, only claims 1 and 41 are independent. Applicant respectfully submits that Slepetys and Bilimoria, regardless of whether they are viewed

individually or as a whole, fail to render *prima facie* obvious all of the subject matter recited in independent claims 1 and 41.

Each of independent claims 1 and 41 are directed to a composition comprising calcined kaolin, wherein “the total of alkali and alkaline earth metals present in the composition is less than or equal to about 0.6% by weight, relative to the total weight of the composition.” Neither Slepetys nor Bilimoria discloses at least this subject matter recited in independent claims 1 and 41. Further, the rejection statement has failed to provide a legally sufficient reason why it would have been obvious to one of ordinary skill in the art to modify the teachings of Slepetys and Bilimoria, such that the kaolin compositions disclosed in those references have the recited range of alkali and alkaline earth metals.

The rejection statement concedes that neither Slepetys nor Bilimoria discloses the recited range of alkali and alkaline earth metals. Final Office Action at 4. However, the rejection statement asserts that because some “clays naturally include less than about 1.0% alkali and alkaline earth metals,” it would have been obvious to one of ordinary skill in the art to select such clays for use in the kaolin compositions disclosed in Slepetys and Bilimoria. Id.

Applicant respectfully disagrees with the assertion and traverses the claim rejection at least because there is no disclosure in the prior art of record that identifies the amount of alkali and alkaline earth metals in kaolin as being a characteristic of interest, or that choosing naturally occurring clays having less than 0.6% by weight of alkali and alkaline earth metals serves any purpose. Thus, rather than relying on the teachings of the prior art, the rejection statement has relied on Applicant’s disclosure

and improper hindsight reasoning to assert that independent claims 1 and 41 are obvious.

The rejection statement indicates an apparent belief that *all* clays from the Rio Capim region of Brazil have an alkali and alkaline earth metal content of less than 1.0% by weight. See id. Contrary to that belief, however, only a fraction of Rio Capim clays have an alkali and alkaline earth metal content less than or equal to about 0.6% by weight. The prior art of record fails to identify any reason one of ordinary skill in the art would select such clay from among all of the clay in the Rio Capim region. Likewise, the rejection statement has failed to identify any such reason. Therefore, Applicant respectfully disagrees with the assertion that “it would have been obvious to one of ordinary skill in the art to employ Rio Capim clay,” and further, that “[t]he limitation on the level of alkali and alkaline earth metals would flow naturally from modification that [Bilimoria] would motivate on[e] of ordinary skill to make.” Id. at 5. Not all clay from the Rio Capim region have an alkali and alkaline earth metal content less than 0.6% by weight, and thus, the level of alkali and alkaline earth metal recited in independent claims 1 and 41 does not “naturally flow from” modifying the compositions of Slepetys and Bilimoria to include Rio Capim clay.

For at least the above-outlined reasons, Slepetys and Bilimoria fail to disclose or render obvious all of the subject matter recited in independent claims 1 and 41. Therefore, those references do not render independent claims 1 and 41 *prima facie* obvious. Thus, the § 103(a) rejection of independent claims 1 and 41 based on Slepetys and Bilimoria should be withdrawn. Further, claims 2-12, 17, and 20 depend from independent claim 1, and thus, those claims are distinguishable from Slepetys and

Bilimoria for at least the same reasons as independent claim 1. Therefore, Applicant respectfully requests reconsideration of the rejection of claims 1-12, 17, 20, and 41 under § 103(a) based on Slepetys and Bilimoria.

IV. Conclusion

For at least the reasons set forth above, independent claims 1, 41, and 44 should be allowable. Dependent claims 2-12, 17, 20, and 45 depend from one of allowable independent claims 1 and 44. Consequently, those dependent claims should be allowable for at least the same reasons as independent claims 1 and 44. Further, withdrawn claims 13-16, 18, 19, 21, and 22 depend from allowable independent claim 1. Thus, those withdrawn claims should also be rejoined, examined, and allowed.

Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, rejoinder and examination of withdrawn claims 13-16, 18, 19, 21, and 22, and allowance of claims 1-22, 41, 44, and 45.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: _____



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